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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/702,040	11/06/2003	Kohichi Yuasa	116692004700	7415
25227 7590 02/03/2009 MORRISON & FOERSTER LLP 1650 TYSONS BOULEVARD SUITE 400 MCLEAN, VA 22102				
EXAMINER				
HOAR, COLLEEN A				
ART UNIT		PAPER NUMBER		
3622				
MAIL DATE		DELIVERY MODE		
02/03/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary****Application No.**

10/702,040

**Applicant(s)**

YUASA ET AL.

**Examiner**

Colleen Hoar

**Art Unit**

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date: \_\_\_\_\_

## **DETAILED ACTION**

### ***Status of Claims***

Claims 1-13 are amended. Claims 1-13 are pending.

Examiner's note: Examiner has pointed out particular references contained in the prior art of record in the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the **entire** reference as potentially teaching all or part of the claimed invention, as well as the content of the passage as taught by the prior art or disclosed by the Examiner.

The US Patent and Trademark Office has vacated the Notice of Non-Compliant Amendment of 6/4/2008; this Office Action is responsive to the papers filed 2/4/2008.

### ***Information Disclosure Statement***

The information disclosure statement (IDS) submitted on 1/23/2008 was filed after the mailing date of the Non Final Rejection on 11/8/2007. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

### ***Claim Rejections - 35 USC § 102***

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1-13 rejected under 35 U.S.C. 102(b) as being anticipated by Lacek et al. (2003/0040964) hereinafter referred to as Lacek.

Claim 1,4, 9, 12-13, Lacek discloses At Transfer State 516 the user is presented with options such as transferring points to another person, emailing a

question or concern to customer service, or viewing frequently asked questions regarding the transfer of points. At Transfer Form State 518 the user is able to transfer points to another person via an online transfer form at a predetermined rate plus applicable taxes and any per transaction handling fees.(Page 9, Para 92); These credits may be purchased for one's own account or for others, transferred between accounts for a fee, and may also be purchased by business entities as incentives or considerations for employees or customers. (abstract) The present invention further provides for a member to transfer points to other people via an online transfer form at a rate per point or a set fee... Upon completion, both the transferor and transferee may be sent an email verification confirming the transaction/deposit. The points are posted to the transferee's account after the completion of the transaction immediately by a real-time link or in a batch transmission. In another embodiment, the recipient does not have to be a member. However, prior to accepting the point transfer, the ....(page 2, Para 19); At Purchase/ Transfer State 500 the user can have several options pertaining to point-based transactions, however, in a preferred embodiment the options consist of a purchase option allowing individual members to purchase points for self-use or for another member, a transfer option allowing individual members to transfer point balances between them or non-members, an option to purchase an elite member status, (Page 4, Para 38); This may be effected, for example, by a database query directed to a server hosting a participating partner's point database. (Page 5 , Para 69); This may be effected, for example, by database commands or instructions to servers hosting the loyalty programs database,(Page 5, Para 75); a database for maintaining

the current credits balance of a user of the system; computerized means for the reduction of the credits balance, said reduction being approximately proportional to a discount offered to the user by a vendor. (Page 12, Claim 9); In a preferred embodiment, points that expire prior to being deposited are automatically rendered invalid and will not be refunded or extended. (page 11, Para 104); all point cap and expiration rules are managed and validated through program administrators. Further, transactional history is maintained to enforce cap/expiration standards thus minimizing the administrative burden on the program administrators.(Page 11, Para 110)

Claim 2-3, Lacek discloses At Initial Account State 202, the user enters information concerning the eligible loyalty programs in which the user is a participating member. (Page 4, Para 40); In a preferred embodiment, a user does not have to be a member in order to purchase points for another person. Therefore, a user does not have to register or sign-in in order to purchase points and can therefore continue to Gift Purchase Form State 510 without being rerouted to Sign-In State 300, Registration State 200, or other authentication procedure. (Page 8, Para 87) At Claim Transfer State 520 a member is able to collect their transfer points. Typically a member would only have to go to Claim Transfer State 520 if either the transferor did not know the member's account number or the transferee was not a member at the time of the transfer. This is because the transferee does not have to be a member until they wish to redeem the transfer claim code. Then the transferee must join and receive an account number before claiming their transfer. At Claim Transfer State 520 the transferee would

input their name, account number, and their claim code number. Once all this information is entered the transferred points may be instantly credited to the recipient's account. Again, the points can be kept in a stored value code for some set period, e.g., one year in a preferred embodiment, before the transferor is given an opportunity to reclaim the transferred points before they are forfeited. [Account number of giving member and receiving member match] (Page 9, Para 94).

Claim 5, 8, 11, Lacek discloses Fig. 5, Request Rule State [50]; After the user enters all of the required information concerning the loyalty programs of the participating sponsors that the user wishes to include in his or her system profile, the information is confirmed for accuracy. This confirmation can be performed in a variety of manners. In the preferred embodiment, the system electronically communicates with each sponsor that the user has requested for inclusion. This communication could be performed by the system accessing the Internet website of each designated sponsor in order to obtain and confirm the user's information. (Page 4, Para 42).

Claim 6, Lacek discloses The system then proceeds to Order Update State 418 where the user's transaction is updated to show the credits applied to the purchase of the product or service and the updated cost of the transaction.(Page 6, Para 74); Account Update State 422, the user's account information is updated to reflect the credits used by the user in the transaction to purchase the product or service. The system can also update the award points deducted from the appropriate affiliate

sponsor accounts, notify the relevant affiliate sponsors or retailers and update the loyalty program points accordingly (Page , Para 75).

Claim 7, 10, Lacek discloses in the system to sign into the system. At Sign-in State 300, the user is asked to provide appropriate identifying information. Such information would typically include the user's identification code and unique password or other authentication data. In a preferred embodiment of the subject invention, the login/authentication communication link and subsequent links are established using a secure protocol such as https, or another suitable PKI, tunneling, or key encryption scheme. [0051] Once the user has entered the requisite information, the information is verified by the system at Sign-in Verification State 302. If the user's sign-in is not verified by the system at Sign-in Verification 302, the user is returned to Sign-in State 300 and asked to reenter the appropriate information. The system then attempts to verify the new information at Sign-in Verification State 302. If the system cannot verify the new information entered by the user, then the user is returned to Sign-in State 300 and again requested to enter the correct information. (Page 5, Para 50-51)

### ***Response to Arguments***

Applicant's arguments file on 11/12/2008 have been fully considered but are not persuasive. Applicant's arguments with respect to claims 1-13 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Colleen Hoar whose telephone number is (571)270-3447. The examiner can normally be reached on Monday- Thursday 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeffrey D. Carlson/  
Primary Examiner, Art Unit 3622

Colleen Hoar  
Examiner  
Art Unit 3622

/C. H./1/28/2009